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Application Number	09/258,601
Filing Date	February 26, 1999
First Named Inventor	Jonathan Shneidman
Art Unit	2673
Examiner Name	Nitin Patel

Total Number of Pages in This Submission	15	Attorney Docket Number	83315.0001

ENCLOSURES *(Check all that apply)*

- [✓] Fee Transmittal Form
  - [✓] Fee Attached
- [ ] Amendment/Reply
  - [ ] After Final
  - [ ] Affidavits/declaration(s)
- [ ] Extension of Time Request
- [ ] Express Abandonment Request
- [ ] Information Disclosure Statement
- [ ] Certified Copy of Priority Document(s)
- [ ] Reply to Missing Parts/ Incomplete Application
  - [ ] Reply to Missing Parts under 37 CFR 1.52 or 1.53

- [ ] Drawing(s)
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- [ ] Petition to Convert to a Provisional Application
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Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Chen Yoshimura LLP		
Signature	/Ying Chen/		
Printed name	Ying Chen		
Date	March 22, 2007	Reg. No.	50193

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FEE TRANSMITTAL
For FY 2006

[✓] Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT	($)	250

Complete if Known

Application Number	09/258,601
Filing Date	February 26, 1999
First Named Inventor	Jonathan Shneidman
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Attorney Docket No.	83315.0001

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1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES Fee ($)	Small Entity Fee ($)	SEARCH FEES Fee ($)	Small Entity Fee ($)	EXAMINATION FEES Fee ($)	Small Entity Fee ($)	Fees Paid ($)
Utility	300	150	500	250	200	100	_____
Design	200	100	100	50	130	65	_____
Plant	200	100	300	150	160	80	_____
Reissue	300	150	500	250	600	300	_____
Provisional	200	100	0	0	0	0	_____

2. EXCESS CLAIM FEES

Fee Description	Fee ($)	Small Entity Fee ($)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 20 or HP =	_____ x	_____ =	_____

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 3 or HP =	_____ x	_____ =	_____

HP = highest number of independent claims paid for, if greater than 3.

Multiple Dependent Claims

Fee ($)	Fee Paid ($)
_____	_____

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If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is $250 ($125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee ($)	Fee Paid ($)
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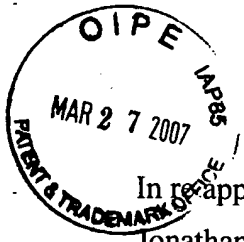|	Fees Paid ($)
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SUBMITTED BY

Signature	/Ying Chen/	Registration No. (Attorney/Agent) 50193	Telephone 213-625-5076
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	Art Unit: 2673
Jonathan Shneidman	Examiner: Nitin Patel
Serial No.: 09/258,601	
Confirmation No.: 4087	
Filed: February 26, 1999	
For: TELESCREEN OPERATING METHOD	

APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is an Appeal from the Examiner's Final Rejection of claims 21-54. The Final Rejection was issued on September 21, 2006. A Notice of Appeal was mailed to the Patent and Trademark Office on January 22, 2007.

REAL PARTY IN INTEREST

The real party in interest is Jonathan Shneidman.

RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

STATUS OF CLAIMS

Claims 21-54 are pending. Claims 1-20 are canceled. This Appeal is directed to the final rejection of claims 21-54, a copy of which appears as a Claims Appendix to this Appeal Brief.

STATUS OF AMENDMENTS

No amendment was filed subsequent to the final rejection.

Appl. No. 09/258,601   Attorney Docket No. 83315.0001

Customer No. 53720

SUMMARY OF CLAIMED SUBJECT MATTER

The present application relates to a communication method and apparatus that allows a user to communicate with information sources (such as Web servers storing Web pages) using a relatively simple interface device. The interface device has a plurality of input elements arranged in a telephone keypad arrangement, but does not have full alphabetic input elements. For example, one embodiment of the input device has a twelve-key pad including input devices that have ten numeric keys 0 - 9 and * and # keys as typically used on a telephone keypad, but does not have a full alphabetic or alphanumeric keyboard as typically used with computers. The interface device also has a display screen for displaying information to the user. Examples of the interface device are shown in, for example, Figs. 10, 10A, 10B and 16 of the instant application, which show a telephone digit pad 40 (see also the specification at page 19, lines 3-10).

The interface device may be in the form of a hand set communicating with a base unit, or on the base unit itself. Figs. 1, 3, 12, 16, among others, depict the base unit 1. Figs. 2, 4-9, 10, 11, 16, among others, depict the handset 2.

A database is provided that associates network identification of the information source (e.g. Web addresses, referred to as URLs) with telephone numbers. When the user inputs a telephone number using the telephone-style keypad of the interface device, the communication apparatus looks up the database to obtain the corresponding Web address, connects to that Web server, and displays the Webpage to the user via the interface device. (See the specification at, e.g., page 6, line 16 to page 7, line 1 and page 10, line 25 to page 11, line 3.) Independent claims 21 and 34 are directed to this communication method.

When information is displayed to the user on the interface device, the user may use the input device to interact with the information source. The information displayed on the screen of the interface device has active areas defined on the screen; when the user selects an active area, an associated code is transmitted to the information source indicating the user selection. See Figs. 21-27; the specification at page 26, line 14 to page 27, line 3 and page 29, line 1 to page 30, line 7; and the original claim 1 on page 31. Independent claim 34 is further directed to such a user interaction method.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

There are two issues on Appeal:

I.   Whether the Final Office Action dated September 21, 2006 (the "Final Office Action") properly rejects claims 21, 24, 25 and 29-34 under 35 U.S.C. §102(e) as being anticipated by Gifford (U.S. Patent No. 5,812,776); and

II.   Whether the Final Office Action properly rejects claims 22, 23, 26-28 and 35-54 under 35 U.S.C. §103(a) as being unpatentable over Gifford (U.S. Patent No. 5,812,776) in view of Pardo (U.S. Patent No. 6,266,539).

ARGUMENT

I.   The Rejection of Claims 21, 24, 25 and 29-34

The applicant respectfully submits that claims 21, 24, 25 and 29-34 are not anticipated by Gifford (U.S. Patent No. 5,812,776).

        A.   Claims 21, 24, 25 and 31-34

The present application relates to a communication system which utilizes a database to associates network identification (such as Web addresses, or URLs) with telephone numbers and which allows a user to connect to information sources (such as Web servers) by inputting telephone numbers using a relatively simple input device without having to use a full keyboard. The information from the information source (e.g. Web pages) are then displayed to the user. Conventionally, a full keyboard is used to communicate with an information source over a network because such information sources are identified only by identifiers such as URLs made of alphanumeric characters. The combination of the database that associates network identification with telephone numbers and the relatively simple input device, as presently claimed, has the practical advantage that users unfamiliar with computers can still communicate with information sources over the network. To emphasize this aspect of the invention, independent claims 21 and 34 expressly recite entering an input "using an input device having a plurality of input elements arranged in a telephone keypad arrangement but without full alphabetic input elements." As the applicant stated in the Amendment dated August 19, 2005, this claim language is intended to include, for example, input devices that have ten numeric keys 0 - 9 and optionally * and # keys as typically used on a telephone keypad, and optionally a small number of other control keys, but exclude an input device that has a full alphabetic or

alphanumeric keyboard or full alphabetic or alphanumeric input capabilities, as typically used with computers and some personal digital assistant devices (PDAs).

The cited Gifford reference does not teach such a combination. Gifford does teach a database that maps telephone numbers to network addresses (see Gifford, Fig. 6, "NUMBER to URL Database" 604; see also col. 7, line 47 to col. 8, line 23). Gifford, however, does not teach inputting the NUMBER using "an input device having a plurality of input elements arranged in a telephone keypad arrangement but without full alphabetic input elements." Gifford shows a plurality of computers 30, 12, etc. connected to the Internet (*id.*, Fig. 1). Clearly, such computers use full alphanumeric keyboards for data input. This is further confirmed by the observation that in Gifford, the number to URL mapping is one of the alternative ways of inputting a network identification into the computer. For example, within the paragraph that describes the number to URL mapping embodiment, the specification states that "[i]n another embodiment an identifier other than a number may be provided. For example, a user may enter a company name or product name ... Multiple identifiers can also be used, such as a telephone number in conjunction with a product name or extension." (*Id.*, col. 8, lines 5-12.) Thus, the goal of the Gifford system is to provide a flexible way of inputting network identifiers by allowing alternative identifications to be used. To obtain the benefit of such a flexible input methods, a full alphanumeric keyboard is needed.

In the Final Office Action, the Examiner stated that Gifford teaches inputting telephone numbers using "the right side of the hot keys which only have numbers 0 to 9." (The Final Office Action, page 2.) The applicant respectfully submits that even when a full alphanumeric keyboard has a separate area with number keys, the keyboard is not the claimed "input device having a plurality of input elements arranged in a telephone keypad arrangement but without full alphabetic input elements."

For these reasons, the applicant respectfully submits that Gifford fails to teach or suggest the element of claims 21 and 34, "entering into a first computer an input indicating a telephone number for an information source <u>using an input device having a plurality of input elements arranged in a telephone keypad arrangement but without full alphabetic input elements</u>" (emphasis added). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." <u>Verdegaal Bros. v. Union Oil Co. of California</u>, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed.

Cir. 1987). Because Gifford fails to teach at least the above element of claims 21 and 34, Gifford does not anticipate independent claims 21 and 34. Further, Gifford does not anticipate claims 24, 25 and 31-33 because they depend from claim 21.

B. Claims 29 and 30

Claim 29 requires the database that stores the network identification associated with telephone number to be pre-stored in the first computer. Claim 30 requires the pre-stored database to be dynamically updated. (These claims are supported by the specification at, for example, page 10, lines 27-29.) Gifford does not teach the NUMBER to URL database 604 being stored in the first computer (i.e. the client 601). Rather, the client 601 sends the NUMBER to a directory server 602, which accesses the NUMBER to URL database and returns the URL to the client 601. (See Gifford, Fig. 6 and col. 7, line 47 to col. 8, line 23.) Therefore, Gifford does not anticipate claims 29 and 30.

II. The Rejection of Claims 22, 23, 26-28 and 35-54

The applicant respectfully submits that claims 22, 23, 26-28 and 35-54 are not obvious under 35 U.S.C. §103(a) over Gifford (U.S. Patent No. 5,812,776) in view of Pardo (U.S. Patent No. 6,266,539).

A. Claims 22, 23, 35, 36, 48 and 49

Claims 22 and 35 recites: "first computer establishing a voice telephone connection with the information source." Claims 23 and 36 recites: "the information source establishing a voice telephone connection with the first computer after the first computer establishes the network connection." Claims 48 and 49 recites: "the first computer transmitting voice information from its user to the second computer after establishing the network connection." (These claims are supported by the specification at, for example, page 6, line 21-31.) Thus, these claims require the first computer to establish a voice telephone connection with the same information source that it has established a network connection with. The Examiner acknowledges that Gifford does not show such features, but cites Pardo for teaching such features. The applicant respectfully submits that Pardo does not teach the claimed feature.

Pardo describes a telephone docking station for a PDA designed to "extend the PDA's functionality to the telephone:"

> A telephone docking station for a personal digital assistant provides a simple docking arrangement in conjunction with a basic telephone circuit that exploits all of the resident intelligence of a PDA in connection with the telephone

circuit to extend the PDA's functionality to the telephone, while extending the telephone's communications capability to the PDA. The docking arrangement preferably consists of a docking slot or port provided within the telephone housing itself by which the PDA is readily received and secured to the telephone, and by which an electrical interconnection or infrared (i.e. digital) is made to the telephone circuitry within the telephone housing. Software installed on the PDA implements desired communications functions, such as automatic dialing of a phone number stored in the PDA directory, the receipt and transmission of email, provides the ability to access electronic networks, such as the Internet, e.g. to browse the World Wide Web, and various custom calling services such as: three-way calling, call forwarding caller-id blocking, and call return. (Pardo, Abstract.)

While the telephone provides the physical structure for a network connection, the network access methods used by the PDA is conventional:

> With regard to network functions, the PDA software would include various modem protocols and/or such protocols as TCP/IP to enable the sending and receiving of email and Internet access. Accordingly, any email client and/or web browser may be included in the PDA software. The telephone itself merely provides a connection to the PDA, for example via a serial port, a power supply, a phone connector, a telephone circuit, and a modem (alternatively, the modem may be implemented in software in the PDA). The PDA provides all of the higher level functionality. (*Id.*, col. 6, lines 37-47.)

While the PDA has an ability to dial telephone numbers contained within a Web page, this appears to be a simple calling function; Pardo does not teach or suggest that the telephone number being dialed and the Web page are associated with the same information source:

> With regard to dialing from a Web page (stated above): When the Web browser detects a string of numbers that looks like a telephone number, the string of numbers is automatically converted to a link in URL format. This link points to an internal callback function in the PDA software that performs the dialing if the user selects the link. (*Id.*, col. 6, lines 51-56.)

Accordingly, the applicant submits that Pardo does not fairly teach or suggest the subject matter of claims 22, 23, 35, 36, 48 and 49.

Moreover, it would not have been obvious to combine Gifford and Pardo. The Examiner argued that "it would have been obvious ... to incorporate the teaching of Pardo's voice telephone with Gifford's networking system because it would have allowed a user navigate [sic] the proper internet address with combination of speech or voice for better navigation." The applicant disagrees because Pardo does not teach voice telephone as a way of assisting

navigation; Pardo merely teaches using the software capability of the PDA to make normal voice telephone calls.

The unobviousness of the methods of claims 22, 23, 35, 36, 48 and 49 may be better understood by considering the functionality and advantages of the claimed method that are not attained by either the Gifford or the Pardo references. The methods of the present claims (and the corresponding physical device, referred to in the specification as the Telescreen) create a completely new type of convergent entertainment and communication experience. While the Telescreen uses many existing technologies, it clearly combines them in new and unobvious ways. One of these is an application by which a user dials a telephone number or initiates a call on a handset and then sees the graphical user interface of where they are calling on another linked display surface. Place a call to pizza restaurant and see the restaurants menu and other information on an accompanying screen. Instead of listening to seemingly endless voice prompts when calling somewhere with an interactive voice response system, IVR, or similar system (For this press one, for that press two and so on.....) the user sees all the choices when using the Telescreen. Place a call, see stuff. (See the specification at page 6, line 16 to page 7, line 1.) This user experience achieved by the Telescreen operating method as claimed is not achieved by either the Gifford device or the Pardo device, or a combination of the two. Because this is a convergent device there is the temptation to look at the individual technologies (a number to URL conversion as in Gifford, voice telephone connection as in Pardo) and argue that it would be obvious to combine them to make a new device. But such argument is wrong. The technologies in Gifford and Pardo separately and/or together fail to teach not only the fundamental elements of the claimed method, but also fail to teach even an evolutionary step in the direction of the claimed method.

For the above reasons, claims 22, 23, 35, 36, 48 and 49 are not obvious over Gifford in view of Pardo.

B.   Claims 26-28, 37, 39, 40-47 and 50-54

Claims 26-28, 37, 39, 40-47 and 50-54 depends from claims 21 or 34 and therefore incorporate all elements of the respective base claims, including the element of "entering into a first computer an input indicating a telephone number for an information source using an input device having a plurality of input elements arranged in a telephone keypad arrangement but

without full alphabetic input elements." The applicant submits that Gifford in view of Pardo do not teach or suggest this element of the present claims.

It might be argued that there was a motivation to incorporate the Gifford teaching of a NUMBER to URL database (i.e. method of Fig. 6) into the Pardo system. The applicant submits, however, there is no suggestion in the prior art itself for such a combination. Moreover, even if Gifford and Pardo could be combined in this fashion, the resulting system still does not have every element of the present claim because the combined system would still have a full alphanumeric keyboard or full alphanumeric input capability. In the Pardo system, docking the PDA with the telephone not only extends the software capability of the PDA to the telephone, it also extends the input capability of the PDA to the docket system. Figs. 3 and 4 of Pardo show a PSION style PDA 31 with a full alphanumeric keyboard (see col. 7, lines 19-22). Figs. 10A, 10B, 11A and 11B show a Palm-Pilot style PDA 41 or 51 which also has a full alphanumeric input capability (col. 9, lines 21-36). There would be no motivation to modify the Pardo system to make "an input device having a plurality of input elements arranged in a telephone keypad arrangement but without full alphabetic input elements" as claimed in claims 21 and 34 (the base claims of claims 22, 23, 35 and 36). Accordingly, claims 26-28, 37, 39, 40-47 and 50-54 are not obvious over Gifford in view of Pardo.

C.   Claims 38

Claim 38 recites: "wherein the input device is a handset unit in wireless communication with the first computer, the handset unit having a touch sensitive screen, at least a portion of the touch sensitive screen being mapped to a portion of the display screen of the first computer." (This claim is supported by the specification at, for example, page 16, lines 24-29.) Neither Gifford nor Pardo teach or suggest such a structure. Gifford discloses a conventional computer (Fig. 1) and does not show a handset having a screen. In the Pardo system, if the telephone docking station is deemed the claimed "first computer" and the PDA is considered the claimed "handset," the telephone station does not have a display screen that is mapped to the screen of the PDA. Accordingly, claim 38 is patentable over Gifford in view of Pardo.

In summary, the applicant respectfully submits that claims 21-54 are patentable over Gifford and Gifford in view of Pardo.

The present Brief is submitted along with an Appendix containing the appealed claims and the requisite brief fee.

Respectfully submitted,

Date: March 22, 2007

By: ___/Ying Chen/_____
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CLAIMS APPENDIX: CLAIMS 21-54 ON APPEAL

21. A method for communicating information between computers, comprising:

entering into a first computer an input indicating a telephone number for an information source using an input device having a plurality of input elements arranged in a telephone keypad arrangement but without full alphabetic input elements;

the first computer obtaining from a database a network identification of the information source based on the telephone number;

the first computer establishing a network connection with a second computer of the information source using the network identification; and

the first computer displaying information obtained from the second computer.

22. The method of claim 21, further comprising a step of the first computer establishing a voice telephone connection with the information source.

23. The method of claim 21, further comprising a step of the information source establishing a voice telephone connection with the first computer after the first computer establishes the network connection.

24. The method of claim 21, further comprising a step of the second computer pushing information to the first computer via the network connection.

25. The method of claim 24, wherein the first computer displays the information obtained from the second computer on a display screen of the first computer, and wherein the information pushed by the second computer includes identifying codes associated with one or more active areas of the first computer's screen, the method further comprising a step of the first computer communicating to the second computer identifying codes associated with active areas selected by the user.

26. The method of claim 24, wherein the pushed information includes video information.

27. The method of claim 24, wherein the pushed video information is interactive video information or smart video streaming information.

28. The method of claim 24, wherein the pushed video information is full screen broadcast quality video information.

29. The method of claim 21, wherein the database is pre-stored in the first computer.

30. The method of claim 29, wherein the pre-stored database is dynamically updated.

31. The method of claim 21, wherein the telephone and network connections are established via wired or wireless communication channels.

32. The method of claim 21, wherein the telephone and network connections are established via twisted-pair, broadband cable, fiber-optic, cellular, or satellite communication channels.

33. The method of claim 21, wherein the network connection is via the Internet and the network identification is a Universal Resource Locator (URL) or an IP address.

34. A method of interfacing between a user and an information system including a plurality of networked computers, comprising:

the user entering into a first computer an input indicating a telephone number for an information source using an input device having a plurality of input elements arranged in a telephone keypad arrangement but without full alphabetic input elements;

the first computer obtaining from a database a network identification of the information source based on the telephone number;

the first computer establishing a network connection with a second computer of the information source using the network identification;

the second computer pushing information to the first computer via the network connection, the pushed information including identifying codes associated with one or more active areas defined for a display screen of the first computer;

the first computer displaying information received from the second computer to the user;

the user selecting one or more of the active areas using the input device; and

the first computer communicating to the second computer identifying code associated with the selected active areas.

35. The method of claim 34, further comprising a step of the first computer establishing a voice telephone connection with the information source.

36. The method of claim 34, further comprising a step of the information source establishing a voice telephone connection with the first computer after the first computer establishes the network connection.

37. The method of claim 34, wherein the input device is a part of the first computer or a handset unit in wireless communication with the first computer.

38. The method of claim 34, wherein the input device is a handset unit in wireless communication with the first computer, the handset unit having a touch sensitive screen, at least a portion of the touch sensitive screen being mapped to a portion of the display screen of the first computer.

39. The method of claim 34, wherein the the input device is a handset unit in wireless communication with the first computer, the handset unit having numeric keys corresponding to active areas defined on the display screen of the first computer.

40. The method of claim 21, wherein the database is a database that links telephone numbers to network address information in a cross directory.

41. The method of claim 40, wherein the database further includes name or street address information associated with the telephone number.

42. The method of claim 41, wherein the input indicating a telephone number is the name associated with the telephone number.

43. The method of claim 34, wherein the database is a database that links telephone numbers to network address information in a cross directory.

44. The method of claim 43, wherein the database further includes name or street address information associated with the telephone number.

45. The method of claim 44, wherein the input indicating a telephone number is the name associated with the telephone number.

46. The method of claim 21, wherein the first computer establishes a network connection with the second computer using the telephone number entered by the user as the only input from the user.

47. The method of claim 34, wherein the first computer establishes a network connection with the second computer using the telephone number entered by the user as the only input from the user.

48. The method of claim 21, further comprising:

the first computer transmitting voice information from its user to the second computer after establishing the network connection; and

the second computer recording the voice information.

49. The method of claim 21, further comprising:

the first computer transmitting voice information from its user to the second computer after establishing the network connection; and

the second computer recording the voice information.

50. The method of claim 21, further comprising:

the first computer visually displaying a plurality of menu items each associated with a number between 0 and 9 or a special symbol; and

the first computer transmitting a signal to the second computer indicating a user input in response to the visual display.

51. The method of claim 34, further comprising:

the first computer visually displaying a plurality of menu items each associated with a number between 0 and 9 or a special symbol;

the user proving the first computer an input in response to the visual display using the input device; and

the first computer transmitting a signal to the second computer indicating the user input.

52. The method of claim 51, where the input device is a telephone unit.

53. The method of claim 51, wherein the visual display is displayed on a touch sensitive screen, and the user input is provided using the touch sensitive screen on the input device.

54. The method of claim 34, further comprising:

the user controlling the first computer using a telephone handset, a remote control device, a touch sensitive screen, or voice recognition.